

REMARKS

Applicant acknowledges the Examiner's request for a supplemental paper amending the reissue application as required by 37 CFR 1.173(b). Applicant has include an Appendix A that shows the amendments to the claims made in the response dated February 27, 2003 in a manner that complies with 37 CFR 1.173(b).

The Office Action rejects claims 1-19, 21-71, 73-99, and 102-110 under 35 USC 251 as being based on a defective reissue declaration. To the extent that a supplemental declaration may be required, Applicant asks that submission of the supplemental declaration be deferred until the application is otherwise in condition for allowance.

The Office Action rejects claims 1-19, 21-71, 73-99, and 102-110 under 35 USC 251 as violating the recapture rule in view of the 08/091,092 and 08/509,966 applications, which issued as U.S. Patent No. 5,690,676 ("the '676 patent"). Applicants traverse the rejection, the Examiner's characterization of the claims and the prosecution histories, and the application of the elements set forth in *Pannu*.

With respect to independent claims 89-93, these claims are directed to methods. Method claims were not presented in the 08/091,092 and 08/509,966 applications and, therefore, claims 89-93 are not subject to the recapture rule in view of these applications.

With respect to independent claims 19, 36, 52, 71, 77, 88, 94-98, 102, 108, 109, and 110, the examiner has failed to address at least the third element of *Pannu*, i.e., whether the claims were materially narrowed in other aspects to avoid the recapture rule in view of the 08/091,092 and 08/509,966 applications.

Reissue claims 19, 36, 52, 71, 77, 88, 94-98, 102, 108, 109, and 110 have been materially narrowed in other aspects relative to the claims of the '676 patent, and therefore, these claims, and those that depend from them, are not subject to the recapture rule.

In particular, as compared to independent claims 1 and 13 of the '676 patent, claim 19 limits the anchor to "a rigid body defining a generally transverse, circumferentially bounded opening extending through said body for receiving the suture" and limits the "rigid body" to having "a non-helically extending exterior enlargement [that] comprises a circumferential ridge."

Claim 36 limits the anchor to “a body having a cylindrical exterior surface” and “a non-helical circumferential ridge extending from the cylindrical exterior surface of said body,” and limits the “body” to “defining a single, circumferentially bounded opening for receiving the suture.”

Claim 52 limits the anchor to “a rigid body defining a generally transverse opening extending through said body for receiving the suture, said opening having open ends,” and limits the “rigid body” to “having an outer surface defining a pair of suture receiving channels, each suture receiving channel being aligned with one of said open ends.”

Claim 71 limits the anchor to “a rigid body defining a generally transverse opening extending through said body for receiving the suture,” and limits the “rigid body” to “having an exterior enlargement configured to enable the anchor to be non-rotationally advanced into a bone hole[,] said enlargement comprises a non-helical circumferential ridge.”

Claim 77 limits the anchor to “a rigid body defining a generally transverse opening extending through said body for receiving the suture,” and limits the “rigid body” to “having a plurality of non-helically arranged, exterior enlargements configured to enable the anchor to be non-rotationally advanced into a bone hole[,] wherein each of said plurality of exterior enlargements comprises a circumferential ridge.”

Claim 88 limits the anchor assembly to including “an anchor body defining an opening for receiving a first portion of [a] suture, and a drive tool for inserting said anchor body in bone” and limits the “drive tool” to “including a mount for releasably receiving a second portion of the suture to enable said anchor body to be secured to said drive tool at least in part by attaching the second portion of the suture to the mount.”

Claim 94 limits the anchor to “a rigid body defining a generally transverse opening extending through said body for receiving the suture,” limits the “rigid body” to “having a non-helically extending exterior enlargement,” and limits the “rigid” body to having “a pointed distal end.”

Claim 95 limits the anchor to “a body having a cylindrical exterior surface” and a plurality of non-helical circumferential ridges extending from the cylindrical exterior surface of

said body[, wherein] at least one circumferential ridge [has] an outer diameter which differs from an outer diameter of another of said circumferential ridges,” and limits the “body” to “defining an opening for receiving the suture.”

Claim 96 limits the anchor to “a body having a cylindrical exterior surface and a rounded distal end” and “a non-helical circumferential ridge extending from the cylindrical exterior surface of said body” and limits the “body” to “defining an opening for receiving the suture.”

Claim 97 limits the anchor to “a body having a cylindrical exterior surface and a pointed distal end” and “a non-helical circumferential ridge extending from the cylindrical exterior surface of said body” and limits the “body” to “defining an opening for receiving the suture.”

Claim 98 limits the anchor to “a body having a cylindrical exterior surface” and “a non-helical circumferential ridge extending from the cylindrical exterior surface of said body ,” and limits the “body” to “defining an opening for receiving the suture, said opening having open ends” and “having an outer surface defining a pair of suture receiving channels, each suture receiving channel being aligned with one of said open ends.”

Claim 102 limits the anchor to “a rigid body defining a generally transverse, circumferentially bounded opening extending through said body for receiving the suture” and limits the “rigid body” to “having a plurality of non-helically arranged, exterior enlargements[, wherein] each of said plurality of exterior enlargements comprises a circumferential ridge.

Claim 108 limits the anchor to “a rigid body having a pointed distal end and defining a generally transverse, circumferentially bounded opening extending through said body for receiving the suture” and limits the “rigid body” to “a non-helically extending exterior enlargement.”

Claim 109 limits the anchor to “a rigid body having a pointed distal end and defining a generally transverse opening extending through said body for receiving the suture” and limits the “rigid body” to “having an exterior enlargement configured to enable the anchor to be non-rotationally advanced into a bone hole.”

Claim 110 limits the anchor to “a rigid body defining a generally transverse opening extending through said body for receiving the suture, said opening having open ends” and limits

Applicant : DiPoto et al.
Serial No. : 09/447,228
Filed : November 22, 1999
Page : 5 of 9

Attorney's Docket No.: 00167-368001 / 02-31-0314

the "rigid body" to "having an outer surface defining a pair of suture receiving channels, each suture receiving channel being aligned with one of said open ends and extending to a proximal end of said body" and "having an exterior enlargement configured to enable the anchor to be non-rotationally advanced into a bone hole"

Applicant asks that these rejections be withdrawn and all claims be allowed. Enclosed is a check for the Petition for Extension of Time fee.

Respectfully submitted,

Date: 2/28/05



Kevin E. Greene
Reg. No. 46,031

Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500
Telephone: (202) 783-5070
Facsimile: (202) 783-2331

APPENDIX A

The following shows the amendments made to the claims in the response dated February 27, 2003 shown in a manner that complies with 37 CFR 1.173(b)

Claims 20, 72, and 100-101 have been cancelled without prejudice or disclaimer.

Claims 19, 21, 22, 71, 73, 74, and 77 have been amended as follows:

19. (Twice Amended) An anchor for insertion into a bone hole to secure a suture to bone, comprising:

a rigid body defining a generally transverse, circumferentially bounded opening extending through said body for receiving the suture,

said body having a non-helically extending exterior enlargement for engaging the bone upon insertion to resist withdrawal of said anchor from the bone, wherein said enlargement comprises a circumferential ridge.

21. (Amended) The anchor of claim [20]19 wherein said circumferential ridge includes a distal, chamfered surface.

22. (Amended) The anchor of claim [20]19 wherein said circumferential ridge includes a proximal surface orientated transversely to a longitudinal axis of the body.

71. (Amended) An anchor for insertion into a bone hole to secure a suture to bone, comprising:

a rigid body defining a generally transverse opening extending through said body for receiving the suture,

said body having an exterior enlargement configured to enable the anchor to be non-rotationally advanced into a bone hole and to engage the bone upon insertion to resist withdrawal

of said anchor from the bone, wherein said enlargement comprises a non-helical circumferential ridge.

73. (Amended) The anchor of claim [72]~~71~~ wherein said circumferential ridge [including]includes a distal, chamfered surface.

74. (Amended) The anchor of claim [72]~~71~~ wherein said circumferential ridge includes a proximal surface orientated transversely to a longitudinal axis of the body.

77. (Amended) [The anchor of claim 76] An anchor for insertion into a bone hole to secure a suture to bone, comprising:

a rigid body defining a generally transverse opening extending through said body for receiving the suture,

said body having a plurality of non-helically arranged, exterior enlargements configured to enable the anchor to be non-rotationally advanced into a bone hole and to engage the bone upon insertion to resist withdrawal of said anchor from the bone, wherein each of said plurality of exterior enlargements comprises a circumferential ridge.

Claims 102-110 have been added:

102. An anchor for insertion into a bone hole to secure a suture to bone, comprising:
a rigid body defining a generally transverse, circumferentially bounded opening
extending through said body for receiving the suture,

said body having a plurality of non-helically arranged, exterior enlargements for
engaging the bone upon insertion to resist withdrawal of said anchor from the bone, wherein
each of said plurality of exterior enlargements comprises a circumferential ridge.

103. The anchor of claim 102 wherein each circumferential ridge includes a distal, chamfered surface.

104. The anchor of claim 102 wherein each circumferential ridge includes a proximal surface orientated transversely to a longitudinal axis of the body.

105. The anchor of claim 104 wherein the proximal surface is perpendicular to the longitudinal axis of the body.

106. The anchor of claim 102 wherein said circumferential ridges have outer extents of about the same diameter.

107. The anchor of claim 102 wherein at least one circumferential ridge has an outer diameter which differs from an outer diameter of another of said circumferential ridges.

108. An anchor for insertion into a bone hole to secure a suture to bone, comprising: a rigid body having a pointed distal end and defining a generally transverse, circumferentially bounded opening extending through said body for receiving the suture, said body having a non-helically extending exterior enlargement for engaging the bone upon insertion to resist withdrawal of said anchor from the bone.

109. An anchor for insertion into a bone hole to secure a suture to bone, comprising: a rigid body having a pointed distal end and defining a generally transverse opening extending through said body for receiving the suture, said body having an exterior enlargement configured to enable the anchor to be non-rotationally advanced into a bone hole and to engage the bone upon insertion to resist withdrawal of said anchor from the bone.

110. An anchor for insertion into a bone hole to secure a suture to bone, comprising:
a rigid body defining a generally transverse opening extending through said body for
receiving the suture, said opening having open ends,

said body having an outer surface defining a pair of suture receiving channels, each
suture receiving channel being aligned with one of said open ends and extending to a proximal
end of said body, and

said body having an exterior enlargement configured to enable the anchor to be non-
rotationally advanced into a bone hole and to engage the bone upon insertion to resist withdrawal
of said anchor from the bone.